

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY, DOCKET NO.
08/230, 083	04/20/94	KRAUS	W TRW21364

FAY, SHARPE, BEALL, FAGAN,
MINNICH & MCKEE
1100 SUPERIOR AVE., STE 700
CLEVELAND OH 44114-2518

QM01/1109

EXAMINER
JOYCE, HART UNIT
3744 PAPER NUMBER11/09/99
DATE MAILED:

30

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/230,083	Applicant(s) Willibald Kraus
	Examiner H. Joyce	Group Art Unit 3744

Responsive to communication(s) filed on Jun 3, 1999

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three (3) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-14 and 16 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) 1-13 is/are allowed.

Claim(s) 14 and 16 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Recapture Issues and Rejection

1. During the prosecution of S.N. 07/642,475, which matured into U.S. Patent No. 5,105,731 claims 1, 3-5 and 7-11 were rejected under 35 USC 103 as being unpatentable over either Feles et al. or Frien in view of Mizusawa, but claims 2 and 12-14 were only objected to and were indicated to be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claim.

In response to that rejection, applicant filed an amendment in which claims 2 and 12 were canceled and were rewritten in independent form and the statement was made that "the claims as now presented were patentable over all of the prior art of record."

Thus, the prosecution history of U.S. Patent No. 5, 105,731 clearly reveals that applicant surrendered a claim having the scope of claim 1 in an attempt to obtain allowance of the original patent claims. In particular, applicant added the limitations contained in originally presented claim 2 to obtain allowance of his application.

The specific limitations which were added to claim 1 to obtain an allowable claim were:

wherein the inner frame (4) has a surrounding rim (7) carrying rib members (8) spaced transversely with stays (9) extending therefrom and a surrounding frame (1) joining the stays (9).

In this reissue application, applicant has presented claims 14 and 16, none of which recites the limitations added to obtain allowance of the patent.

Each of these claims must be addressed to determine if it violates the recapture doctrine.

Claim 14's scope differs from that of originally filed claim 1 by specifying that there are two clip connections, one of which comprises a springy tongue and is spaced from the surrounding wall, and the other of which comprises a springy tongue which is integral with the surrounding wall. Here, the change in scope, even though narrower than the originally filed claim 1, is merely an obvious duplication of parts which is an unpatentable limitation. Therefore, it does violate the recapture rule. In this regard, see In re Clement, 45 USPQ2d 1161,1165 (Fed. Cir. 1997).

Claim 16 adds no limitations to what was recited in originally filed claim 1; and thus, clearly violates the recapture doctrine.

Claims 14 and 16 are rejected under the equitable "recapture" doctrine which prevents a reissue applicant from obtaining subject matter surrendered in an attempt to obtain allowance of the original patent claims. See, in this regard, In re Clement, 45 USPQ2d 1161, 1164 (Fed. Cir. 1997).

Allowable Subject Matter

2. Claims 1-13 are allowed.

Response to Arguments

3. Applicant's arguments filed June 3, 1999 have been fully considered but they are not persuasive. Applicant is erroneously taking the position that under In re Clement, the surrendered subject matter should be that subject matter added to cause the claim to be patented (see page 6,

last paragraph). To the contrary, notwithstanding the fact that claim 16 recites additional limitations not present in originally filed claim 1, applicant is prohibited from removing the limitation that caused claim 1 to be patented in this reissue application. Compare the statement in Clement cited above, that “[E]ven with the additional limitations, claims 50-52 are also broader than they are narrower in a manner directly pertinent to the subject matter that Clement surrendered during prosecution”, *Ibid.*, at page 1166.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to H. Joyce whose telephone number is 703/308-0274 and whose Group fax number is 703/305-3588.



**HAROLD JOYCE
PRIMARY EXAMINER
ART UNIT 3744**

HJ
November 5, 1999